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Alexander J. Burke Intellectual Property Department 5th Floor 170 Wood Avenue South Iselin, NJ 08830		LUDWIG, MATTHEW J			
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* WALT SINGLETON and FRANK W. RACIS

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Appeal 2009-001744  
Application 10/725,154<sup>1</sup>  
Technology Center 2100

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Decided: February 02, 2010

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*Before* JAY P. LUCAS, STEPHEN C. SIU, and JAMES R. HUGHES,  
*Administrative Patent Judges.*

LUCAS, *Administrative Patent Judge.*

DECISION ON APPEAL

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<sup>1</sup> Application filed December 1, 2003. Appellants claim the benefit under 35 U.S.C. § 119 of provisional application 60/430,220, filed December 2, 2002. The real party in interest is Siemens Medical Solutions Health Services Corporation.

### STATEMENT OF THE CASE

Appellants appeal from a final rejection of claims 1 to 17 under authority of 35 U.S.C. § 134(a). The Board of Patent Appeals and Interferences (BPAI) has jurisdiction under 35 U.S.C. § 6(b).

We reverse.

Appellants' invention relates to a system for document generation from an information repository (Spec. 1, ll. 29-30). In the words of Appellants:

[A] computer information system, such as a hospital information system . . . generally includes an information repository, a document processor, and a graphical user interface. The information repository, representing a memory device for storing information, further includes a source of code representing a document template and a source of document-generation control information.

(Spec. 3, ll. 9-15).

Claim 1 is exemplary, and is reproduced below:

1. A document generation system for producing a document from information derived from an information repository, comprising:

a source of code representing a document template including, data fields containing placeholder items to be replaced by desired data items, and also including a repetition identifier indicating one of said data fields is to be replicated

to provide a group of data fields to be replaced by a plurality of said desired data items;

a source of document generation control information supporting insertion of said desired data items derived from said information repository in said data fields; and

a document processor for applying said control information in replacing template document data field placeholder items with desired data items, to produce a generated document.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Marchal, "Applied XML Solutions: The Authoritative Solution" 71-214, 329-336 (Sams Professional Publishing 2000).

Muench, "Building Oracle XML Applications" 284-309, 375-387, 433-499 (O'Reilly & Assoc., Inc., 1<sup>st</sup> ed. 2000).

## REJECTIONS

The Examiner rejects the claims as follows:

R1: Claim 13 stands rejected under 35 U.S.C. § 112, 1<sup>st</sup> paragraph, as not having support in the Specification.

R2: Claims 1 to 17 stand rejected under 35 U.S.C. § 103(a) for being obvious over Marchal in view of Muench.

Appellants contend that the claimed subject matter is not rendered obvious by Marchal in combination with Muench because Marchal does not

disclose the claim limitation “from information derived from an information repository” (claim 1). The Examiner contends that each of the claims is properly rejected (Ans. 16, top).

The rejections will be reviewed in the order argued by Appellants. The claims are grouped as per Appellants’ Briefs. Only those arguments actually made by Appellants have been considered in this opinion. Arguments that Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

## ISSUE

The issue is whether Appellants have shown that the Examiner erred in rejecting the claims under 35 U.S.C. §§ 103(a) and 112, 1<sup>st</sup> paragraph. The 35 U.S.C. §§ 103(a) issue specifically turns on whether the Marchal reference discloses “from information derived from an information repository” (claim 1).

## FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence.

### *Disclosure*

1. Appellants have invented a system and method for document generation from an information repository (Spec. 1, ll. 29-30). The title of the invention is “A Document Generation System and User Interface for Producing a User Desired Document.”

*Marchal*

2. The Marchal reference is a chapter of a book that discloses making XML templates, as well as a user who manually types information into data fields of the XML (eXtensible Markup Language) templates (p. 73, bottom; p. 78, bottom).

*Muench*

3. The Muench reference discloses sorting and grouping information in an XML document (p. 375, middle).

#### PRINCIPLES OF LAW

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006).

"On appeal to the Board, an applicant can overcome a rejection by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness." *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998) (citations omitted).

#### ANALYSIS

From our review of the administrative record, we find that the Examiner has presented his conclusions of unpatentability on pages 3 to 8 of the Answer. In opposition, Appellants present two arguments.

*Argument with respect to the rejection  
of claim 13  
under 35 U.S.C. § 112, 1<sup>st</sup> paragraph [R1]*

Claim 13 recites, in relevant part, “a text processing application compatible document template.”

First, Appellants argue that various paragraphs of the Specification and “Fig. 2 state [that] an image element enables user selection of a document template.” (App. Br. 9, middle).

In reply, the Examiner maintains that the Specification contains no support for Appellants’ “text processing application compatible document template,” as claimed. (*See* Ans. 9, top.)

We reviewed Appellants’ Specification and the Examiner’s Answer. We agree with Appellants. We find that the disclosed MS Word file (*see* Spec. 7, l. 27) is a well known type of text-processing application file. The Specification further discloses that the MS Word file is saved in Rich Text Format (RTF) as a template file (*id.* at ll. 28-29). Therefore, the Specification supports the claimed “text processing application compatible document template.” Accordingly, we find error in the rejection [R1] of claim 13.

*Arguments with respect to the rejection  
of claims 1 to 17  
under 35 U.S.C. § 103(a) [R2]*

Appellants argue that “Marchal does not derive information from an information repository as [claimed].” (App. Br. 12, middle) (emphasis omitted). Rather, Marchal requires manual user input (*id.*).

In reply, the Examiner finds that Marchal discloses “a source of document generation control information supporting insertion of the desired data items from an information repository” (Ans. 10, middle). The Examiner cites 31 pages of a book chapter that discloses how to create XML (eXtensible Markup Language) templates (FF#2).

“On appeal to the Board, an applicant can overcome a rejection by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.” *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998) (citations omitted).

We find that Appellants’ argument (*i.e.*, the Examiner makes no finding for the claim limitation “from an information repository,” as recited in exemplary claim 1) is persuasive and dispositive (App. Br. 12, middle) for the following reasons.

Appellants’ claimed “system” requires, in relevant part, “desired data items” from information contained in “an information repository” “to produce a generated document.” In contrast, Marchal discloses creating an XML template (FF#2). The claim language and Marchal’s disclosure are not similar, because none of Marchal’s information (Appellants’ claimed desired data items”) is derived “from an information repository,” as claimed. Rather, in Marchal a human user types data (*i.e.*, Appellants’ “desired data items”) into data fields (*id.*). A system, such as Marchal’s, cannot derive “desired data items” from a non-existent information repository. Since Marchal is missing the claimed “information repository,” it logically follows that Appellants’ argument that no “desired data items” are derived “from an information repository” is indeed persuasive (App. Br. 12, middle).

We note here that Marchal’s user would not have been recognized by a person of ordinary skill in the art as the claimed “information repository.” In other words, a user’s manual entry of data is insufficient for purposes of disclosing the claimed system that involves “desired data items” derived “from an information repository,” as argued by Appellants.

Moreover, we find that the Examiner’s combination of Marchal and Muench fails to resolve the above-stated deficiencies since the Examiner limits the relevance of Muench, which discloses sorting and grouping information in an XML environment (FF#3). In his own words, the Examiner states that “[t]he function of repeating data of Muench is merely an add-on enhancement to the basic teachings of the form template of Marchal” (Ans. 10, top). In light of the Examiner’s statement on the record regarding Muench (*id.*) and our analysis of Marchal’s “basic teachings” (*id.*), we find that the proposed combination of references is deficient. Accordingly, we find error in the examination of claim 1.

We selected claim 1 as representative of the claims on appeal. Claims 2 to 17 stand with representative claim 1.

#### CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that the Examiner erred in the rejections [R1 and R2] of claim 13 and claims 1 to 17, respectively.

#### DECISION

The Examiner’s rejections [R1 and R2] of claims 1 to 17 are reversed.

REVERSED

Appeal 2009-001744  
Application 10/725,154

peb

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